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In re Application of OZKAN et al	:	
U.S. Application No.: 09/622,388	:	
Int. Application No.: PCT/US99/03513	:	DECISION ON PETITION
Int. Filing Date: 18 February 1999	:	
Priority Date: 20 February 1998	:	UNDER 37 CFR 1.47(a)
Attorney Docket No.: RCA 88914	:	
For: A MULTIMEDIA SYSTEM FOR ADAPTIVELY	:	
FORMING AND PROCESSING EXPANSIVE	:	
PROGRAM GUIDES	:	

This is in response to applicants' "Petition Under 37 C.F.R. 1.47(a)" filed 10 October 2000, requesting acceptance of the present United States national stage application without the signature of one of the inventors.

### **BACKGROUND**

On 18 February 1999, applicants filed international application PCT/US99/03513, which claimed priority of an earlier United States application filed 20 February 1998. A copy of the international application was communicated to the USPTO from the International Bureau on 26 August 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 11 August 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 20 August 2000.

On 16 August 2000, applicants filed national stage papers in the United States. The submission was accompanied by, inter alia, an authorization to charge the requisite basic national fee required by 35 U.S.C. 371(c)(1).

On 08 September 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a

surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

On 10 October 2000, applicants filed the present petition along with, inter alia, a declaration signed by two of the three joint inventors and an authorization to charge the requisite petition fee and the fee for furnishing a declaration later than thirty (30) months from the priority date. The petition states that it is accompanied by the declaration of Davida Fornarotto, Paralegal Administrative Assistant for Thomson multimedia Licensing Inc. ("Thomson"). Ms. Fornarotto's declaration purportedly establishes that one of the inventors, Mehmet Kemal Ozkan, could not be reached after diligent effort.

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicants have submitted a declaration signed by two of the three inventors on their own behalf and on behalf of the nonsigning inventor Ozkan.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

In the present case, applicants' have supplied a declaration signed by Davida Fornarotto, a person having apparent firsthand knowledge of attempts to reach Ozkan. Fornarotto's declaration and accompanying documentation establish the following with reasonable certainty:

1. On 04 March 1999, Fornarotto sent an electronic mail message to Ozkan asking him to verify his address and to supply his telephone number (see Exhibit "C").
2. On 05 March 1999, Ozkan replied to Fornarotto by electronic mail, verifying his mailing address and supplying three telephone numbers (see "Exhibit C").
3. On 05 March 1999, application papers were sent to Ozkan at his last known

home address (see "Exhibit C").

4. On 25 March 1999, Ozkan via electronic mail confirmed receipt of the application papers and expressed his intention to return the papers in short order (see "Exhibit D").

5. On 05 April 1999, Ozkan responded to an electronic mail inquiry by Fornarotto and restated his intent to return the application papers in short order (see "Exhibit D").

6. On 22 November 1999, having not received any further communication from Ozkan, Fornarotto contacted William Lagoni, Intellectual Property Administrator for Thomson in an attempt to locate Ozkan.

7. On 22 November 1999, Lagoni supplied Fornarotto with Ozkan's business address, Ozkan's business telephone numbers, and a different electronic mail address for Ozkan (see "Exhibit G").

8. On 22 November 1999, Fornarotto sent an electronic mail message to Ozkan at the address supplied by Lagoni but did not receive a reply.

9. On 07 December 1999, Lagoni informed Fornarotto via electronic mail that two electronic mail messages sent from Lagoni to Ozkan had been returned as undeliverable (see "Exhibit I").

10. On 21 July 2000, Fornarotto sent an electronic mail message to Ozkan but did not receive a reply (see "Exhibit J").

Although it is apparent that Fornarotto and Lagoni attempted several times to contact Ozkan by electronic mail, the submitted evidence is insufficient to establish that a diligent effort was made to reach Ozkan. In particular, neither the petition nor its supporting documentation details any attempt to contact Ozkan by telephone even though Fornarotto specifically requested, and received, telephone numbers from Ozkan (see "Exhibit C"). Furthermore, although the petition states that Fornarotto sent a communication to Ozkan via courier on 12 November 1999, Fornarotto's declaration makes no mention of such a communication and its relationship to the present application. Moreover, there is no evidence of any attempt to contact Ozkan following receipt of the Notification of Missing Requirements. Accordingly, on the present record, it is inappropriate to accept the present application without the signature of Ozkan.

With regard to item (3) above, the requisite fee has been charged to Deposit Account No. 07-0832 per applicants' authorization.

With regard to item (4) above, the last known home and business addresses of the nonsigning inventor are provided in the attachments to the petition. See "Exhibit C" and "Exhibit G".

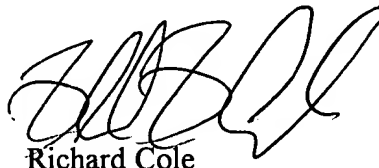
### CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

Bryan Tung  
PCT Legal Examiner  
PCT Legal Office

A handwritten signature in black ink, appearing to read 'Richard Cole', written over the printed name.

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